

BAC *DM*
P/3704-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Steven BARRITZ, et. al.

Date: February 24, 2005

Serial No.: 09/766,438

Group Art Unit: 3622

Filed: January 19, 2001

Examiner: Khanh H. LE

For: A SYSTEM AND METHOD FOR ESTABLISHING INCENTIVES FOR
PROMOTING THE EXCHANGE OF PERSONAL INFORMATION AND
TARGETED ADVERTISING.

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST TO SET ASIDE NOTICE OF ABANDONMENT

Sir:

A Notice of Abandonment was mailed January 21, 2005 stating that no reply was received to the Office Action mailed June 30, 2004.

A Response was mailed to the Patent and Trademark Office on December 30, 2004, along with a Petition for Three Month Extension of time and our check no. 19158 with the fee therefor. A copy of that same response is re-submitted, together with a copy of the return post card stamped "received" by the OIPE on January 3, 2005.

Due to a clerical error, the U.S. Serial number was listed incorrectly on the response. Therefore the Patent and Trademark Office did not match up the response with the file timely mailed December 30, 2004 and consequently is treating the application as abandoned incorrectly. (All of the other data in the response was for the correct application, including the Examiner's name and application title, so that the typographical error in application number on the response might have been noted.)

However, the Patent Office did not call the clerical error to Applicant's attention or give Applicant the opportunity to correct the filing within the time limits of response and did not use any other of the correctly recited data to place the filed document with the correct application.

As Applicants in good faith believed that they had responded timely (as evidenced by the stamped return postcard) and were not notified until the application was incorrectly abandoned, it is requested that abandonment of the application be set aside.

It is submitted that since a timely response was filed, but only with a typographical error in a number, no fee is due for reviving an abandoned application. However, if a fee is due, it should be charged to our Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 24, 2005

Max Moskowitz

Name of applicant, assignee or
Registered Representative

Signature

February 24, 2005

Date of Signature

Respectfully submitted,

MAX MOSKOWITZ

Registration No.: 30,576

OSTROLENK, FABER, GERB & SOFFEN, LLP

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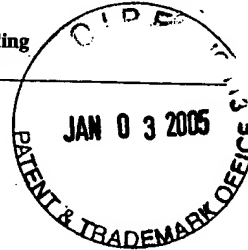
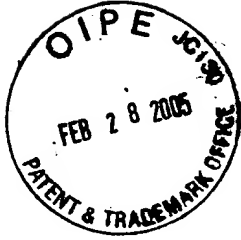
Telephone: (212) 382-0700

Serial No. 09/766418 Filing Date 1/19/01 OFGS File No. P/3704-5
Title A SYSTEM AND METHOD FOR ESTABLISHING...
First Inventor STEVEN GARRITZ Date 12/30/04
The PTO has received: Last Due Date: _____

- ☐ Patent Application of _____
Pages (including claims & abstract)
☐ Declaration or ☐ Designation Sheet
☐ Drawings _____ Sheet(s)/Figs. _____ to _____
☐ Priority Document
☐ Small Entity Declaration
☐ Assignment & Conveyance Cover Sheet
☐ Information Disclosure Statement
☐ PTO-1449
☒ Amendment
☐ Affidavit or Declaration
☐ _____

- ☐ TM Application ☐ ITU Basis
☐ Statement of Use
☒ Extension of Time 3 mos.
☐ Notice of Appeal
☐ Brief
☐ Petition
☐ Status Request
☐ Issue Fee
☒ Certificate of Mailing
☐ Express Mail No. _____

☒ Check No. 19158 for \$ 510-
Atty/Secy MW: CG



****NOTE:** Serial No. should be 09/766,438

P/3704-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Steven BARRITZ, et. al.

Date: December 30, 2004

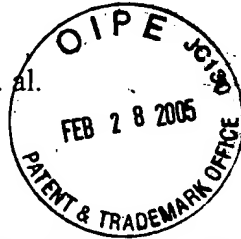
Serial No.: 09/766,418 **

Group Art Unit: 3622

Filed: January 19, 2001

Examiner: Khanh H. LE

For: A SYSTEM AND METHOD FOR ESTABLISHING INCENTIVES FOR
PROMOTING THE EXCHANGE OF PERSONAL INFORMATION AND
TARGETED ADVERTISING.



Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION AND FEE FOR AUTOMATIC EXTENSION OF TIME
UNDER 37 CFR 1.17, 1.136(a) AND 35 USC 41(a)8

Sir:

Applicant(s) hereby petition(s) the Commissioner for Patents to extend the time for filing a response to the outstanding Office Action by three months. Enclosed is our check No. 19158 which includes the amount of \$510.00 for the petition fee in accordance with 37 CFR 1.17 computed as:

☒ Response within third month
_____ not small entity (\$1020) ☒ small entity (\$510)

You are authorized to charge to our Deposit Account No. 15-0700 any additional amounts owing.

If this petition is inadequate to avoid abandonment, the Assistant Commissioner for Patents is petitioned, under 37 C.F.R. §1.136(a), to extend the time by the number of months which will avoid abandonment under 37 C.F.R. §1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 30, 2004

Max Moskowitz
Name of applicant, assignee or
Registered Representative

Signature

December 30, 2004
Date of Signature

Respectfully submitted,

**FILE
COPY**

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****NOTE:** Serial No. should be 09/766,438

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Steven BARRITZ, et. al.

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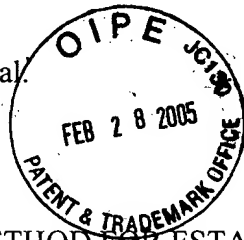
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT/SUBMISSION

Sir:

This is a response to the Office Action mailed June 30, 2004 in the above-identified application. Reconsideration of the application is respectfully requested.

FEE CALCULATION

Any additional fee required has been calculated as follows:

_____ If checked, "Small Entity" status is claimed.

	NO. CLAIMS AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR		EXTRA PRESENT		RATE	ADDIT. FEE
TOTAL	30	MINUS	42	* =	0	X	(\$25 SE or \$50)	\$0
INDEP.	2	MINUS	3	** =	0	X	(\$100 SE or \$200)	\$0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM						X	(\$180 SE or \$360)	\$0

* not less than 20

** not less than 3

TOTAL \$

If any additional payment is required, a check which includes the calculated fee of \$ _____
(OFGS Check No. _____) is attached.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 15-0700.

CONTINGENT EXTENSION REQUEST

If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

SUMMARY OF AMENDMENTS

1. ☐ If checked, an abstract (an amended abstract) is submitted herewith.
2. ☐ If checked, amendment(s) to the drawings are submitted herewith.
3. ☐ If checked, amendment(s) to the specification are submitted herewith.
4. ☒ If checked, amendment(s) to the claims are submitted herewith.

LISTING OF THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. **(Currently Amended)** A public broadcasting system, the system comprising:
 ~~operable with~~ a facility for collecting viewers' profile data and for controlling program
 ~~and/or and~~ advertisement content delivery to customers based on the viewers' profile data, ~~the~~
 ~~system comprising:~~
 ~~viewer profile data and~~ a facility for gathering said viewer profile data and for providing
the viewer profile data to a program and advertising content controlling facility;
 a content selector that ~~selects for~~ provides to viewers program content; and
 an advertising inserter which selects alternate advertising that is intended to selectively
replace or supplement commonly provided advertising content, based on the viewer profile data;
 a facility that sets rewards to viewers based on criteria that is associated with the viewer
profile data provided by viewers; and
 a control which responds to the rewards set by the rewards facility, in a manner which
adjusts the durations of the program content and the durations of the advertising content being
provided to the different ones of said viewers based on their corresponding viewer profile data.
2. **(Original)** The system of Claim 1, in which the broadcasters include point-to-one broadcasters.
3. **(Original)** The system of Claim 1, in which the broadcasters include point-to-few broadcasters.
4. **(Original)** The system of Claim 1, in which the broadcasters include point-to-many broadcasters.
5. **(Canceled)**

6. **(Currently Amended)** The system of Claim [[5]] 1, in which the rewards comprise modifications to the commonly provided advertising content.

7. **(Canceled)**

8. **(Currently Amended)** The system of Claim [[5]] 1, in which the rewards comprise the provision of different types of advertisements.

9. **(Currently Amended)** The system of Claim [[5]] 1, in which the rewards comprise the replacement of the commonly provided advertising content with brief program material.

10. **(Currently Amended)** The system of Claim [[5]] 1, in which the rewards comprise the selection of advertising that are tailored to viewers, based on the viewers' profile information.

11. **(Original)** The system of Claim 1, in which the viewers profile data is provided by viewers in accordance with different levels of specified viewer profile detail so as to enable providing different reward levels.

12. **(Original)** The system of Claim 1, in which insertion of the alternate advertising is effected at an interface facility.

13. **(Original)** The system of Claim 12, in which the interface facility is a central facility which is operated outside of viewers' homes.

14. **(Original)** The system of Claim 12, in which the interface device is a gathering device.

15. **(Original)** The system of Claim 14, in which the gathering device incorporates internal cellular telephone circuitry that automatically communicates with the broadcasters.

16. **(Original)** The system of Claim 15, in which internal cellular telephones associated with a plurality of viewers are operated as party line telephones.

17. **(Original)** The system of Claim 14, in which the gathering device comprises internal storage for storing program content and a facility that plays program content after a delay.

18. **(Original)** The system of Claim 12, in which the interface facility comprises a device located in the home of the viewer.

19. **(Original)** The system of Claim 18, in which the device is selected from a group consisting of: settop box, descrambler, VCR, GD, PTV, television receiver, Web browser and Internet appliance.

20. **(Original)** The system of Claim 1, in which the broadcasters comprises a Web TV deliverer or a real television or a video-on-demand provider.

21. **(Canceled)**

22. **(Currently Amended)** The system of Claim ~~[[5]]~~ 1, in which the rewards comprise a reduction in the frequency ~~or duration~~ of television commercials.

23. **(Currently Amended)** The system of Claim ~~[[5]]~~ 1, in which the rewards comprise a combination of advertisements in advertising pods.

24. **(Currently Amended)** The system of Claim [[5]] 1, in which the rewards comprise the playing of only such commercials that are matched with the viewers' profile data.

25. **(Original)** The system of Claim 1, in which the viewer profile information is communicated to broadcasters via viewer responses to questionnaires.

26. **(Original)** The system of Claim 18, in which the viewer profile information is communicated to broadcasters via remote controller messages transmitted to the respective interface facility located at the respective homes of the viewers.

27. **(Original)** The system of Claim 1, in which the viewer profile information is communicated to the broadcasters via the Internet.

28. **(Original)** The system of Claim 1, in which the viewer profile information is communicated to the broadcasters through authorized release of data from financial institutions.

29. **(Original)** The system of Claim 1, including a facility that selects either the program content or the alternate advertising by means of a server database.

30. **(Original)** The system of Claim 1, including a facility that selects either the program content or the alternate advertising by downloading over the Internet.

31. **(Original)** The system of Claim 1, including a facility that selects either the program content or the alternate advertising by Cable TV or satellite signals transmitted to addressable converters.

32. **(Original)** The system of Claim 1, including a facility that selects either the program content or the alternate advertising by signals transmitted over the air.

33. **(Original)** The system of Claim 1, further including an encryption software that encrypts viewers' profile information provided by viewers.

34. **(Original)** The system of Claim 1, further including a facility that identifies viewers who are actually viewing program content.

35. **(Original)** The system of Claim 34, in which the facility that identifies viewers includes a voice recognition facility.

36. **(Original)** The system of Claim 34, in which the facility that identifies viewers' includes a facility that detects viewers' presence near a television set.

37. **(Original)** The system of Claim 34, in which the facility that identifies viewers' includes a remote controller device operable by the viewers.

38. **(Original)** The system of Claim 1, further including a central entity that manages viewer profile information in a manner that protects the confidentiality of viewers identities from the broadcasters.

39. **(Currently Amended)** A public, over the air, broadcasting system involving broadcasting of live program content divided into segments with intervals separating the segments and advertising content provided in the intervals, the system comprising:

a broadcasting facility for broadcasting the live program content over the air and a plurality of receiving devices for receiving the live program content and for playing the live program content to viewers substantially without delay;

a respective advertising player ~~players~~ coupled with and located at a corresponding one ~~ones~~ of the receiving devices; the advertising player ~~players~~ including a facility for receiving and pre-storing the advertising content; and

an advertising content inserter responsive to viewer profile information and operable with the advertising inserter player and the corresponding receiver for dynamically and interactively inserting portions of the pre-stored advertising content into the live program content being provided to ~~viewers~~ a viewer, in a manner that the pre-stored advertising content and the live program content are presented in integrated form to ~~viewers~~ the viewer, and based on the viewer profile information.

40. (Original) The system of the Claim 39, further including an interface facility that enables viewers to provide viewer profile data to broadcasters.

41. (Original) The system of Claim 40, further including a facility in the advertising content inserter that selects segments from the pre-stored advertising to be inserted in the live broadcast based on viewer profile data of respective viewers.

42. (Original) The system of Claim 39, in which the broadcasters include a radio broadcaster.

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated June 30, 2004. A Petition for Extension of Time (three months) and the fee therefor are enclosed.

Claims 1, 2-4, 12-14, 17-19, 25-26, 28, 31-32, 34, 36, 37 and 39-41 are stated to be anticipated by Wachob (5,155,591), as explained in paragraph 3 of the Office Action. Claims 5, 6-10 and 21-24 are stated to be obvious over Wachob, in view of Garg, et. al. (6,571,216). Claims 15, 16, 20, 27, 29-30, 33, 35 38, 40 and 42 are stated to be obvious over Wachob, in further view of Herz, et. al. (6,088,722), as set forth in paragraph 7 of the Office Action. Finally, Claim 11 is said to be obvious over Wachob, in view of Scroggie (6,014,634), as explained at paragraph 8 of the Office Action. Reconsideration is requested in view of the amendments to the claims herein and the following remarks.

As the title of the application suggests, the present application and claims 1 through 38 are very deeply intertwined with the concept of “incentives for promoting the exchange of personal information”. Individuals do not like to, and often resist, providing personal information. At the same time, public broadcasters would like to, and have always, exerted some measure of targeting advertising to different segments of the population based on demographic considerations. The primary reference, Wachob, is but one example of the variety of systems which comprise “method and apparatus for providing demographically targeted television commercials”. There is no disclosure in this primary reference of any intent to provide or control the dissemination of targeted television commercials based on any “reward” criteria or mechanism.

Independent claim 1 of the instant specification, as amended, is directed to a public broadcasting system, which does not merely concern itself with creating data files which store information about viewer demographics.

Rather, the invention of claim 1, as amended, includes a facility that sets rewards to viewers who provide viewer profile information, based on certain criteria. That criteria is designed to increase the level of rewards based on both the quality and quantity of information provided by the viewer. In this manner, targeting of advertising can be very much improved.

Further in accordance with claim 1, the content selector that provides program content to viewers and the advertising inserter which selects and supplies advertising content, is further controlled by the “rewards” set by the reward setting facility. As specifically recited in claim 1, the rewards include setting the durations of advertising content in some relationship to the rewards that have been set. This might be reducing the durations of the advertising substantially, which would result in less annoyance to viewers.

Wachob does not contain any such system. It sets no “rewards” and it cannot alter the duration of an advertisement to suit a level of rewards which have been set for a particular viewer or a group of them. Indeed, the Office Action recognizes that Wachob does not disclose a system as defined in Claim 1 (as presently amended). Wachob replaces commercials with different commercials or with music or other types of information of identical duration . It does not control duration and does not provide any reward in exchange for a viewer’s cooperation in providing profile information.

The Office Action has therefore turned to the secondary Garg reference, which generically describes a system for providing rewards, per se, to individuals based on their personal profiles. Thus, a central agency provides the reward in exchange for users accessing the central agency via the Internet, telephone, or the like. The rewards are invariably cash or its equivalent, such as discounts on products and services, loyalty points, electronically distributed prizes, free samples, product warranties, tie-in promotions, cross-selling, premiums, memberships, car discounts, organizing contests, sweepstakes, games, etc. There is no disclosure in this secondary reference of tie-in with television advertising or intertwining a reward with the durations of television or broadcast commercials.

Perhaps recognizing that Garg does not disclose the system of the present invention which is structurally configured to provide the ability to reduce advertising duration and increase program content duration, the Office Action generically states (at the second paragraph on page 6 thereof), that: “...describing what the rewards are comprised of, are non-functional data and therefore do not distinguish the claimed invention.” Applicant respectfully, but emphatically, disagrees. In the context of the present invention, the facility that sets the rewards is structurally and functionally intertwined with the program content selector and the advertising inserter and

controls it structurally and functionally, to alter a physical parameters. The structure and the function of the present invention, as set forth in claim 1, is simply not described nor suggested in the prior art. The prior art of record would not lead one of ordinary skill in the art to the invention of claim 1, except if one were to employ (improperly) hindsight to seize on disparate pieces of prior art information and to employ the information provided by the present application to arrive at what is set forth and clearly defined in claim 1 herein.

The remaining ones of the claims which depend on claim 1 include all of its limitations and impose further limitations thereon which distances each of them even further from the prior art. As such, it is respectfully submitted that claim 1 and its dependent claims clearly distinguish over the prior art.

Independent claim 39 is directed to a public, over the air, broadcasting system which involves broadcasting live program content and advertising content as well. The invention as defined in claim 39 includes an advertising player which is coupled with, and located at, a corresponding one of the receiving devices, or, in other words, at the viewer's home or the like. The advertising player includes a facility that receives and pre-stores the advertising content.

Further, an advertising content inserter is both responsive to view profile information and operates with the advertising player and the corresponding receiver of the viewer to dynamically and interactively insert portions of the pre-stored advertising content into the live program content being provided to the given viewer via the public, over the air, broadcasting system. In this manner, advertising that has been pre-stored and live program content are presented in integrated form to a viewer based on the viewer profile information [that is associated with a given viewer].

The Wachob reference is not even remotely similar to or suggestive of the invention of independent claim 39. The Wachob system cannot operate with over the air public broadcasting systems, given that the limited bandwidth spectrums assigned to public television entities such as ABC, NBC, CBS, FOX and the like. No bandwidth is allocated for live, over the air, broadcasts of replacement or substitute commercials.

As a result, the invention of claim 39 uses different means of communications with the advertising players to prestore commercial content therein, recognizing that the commercial

content for a particular viewer could not be broadcast live. They could not be transmitted "live" and still be available in perhaps hundreds of variations to suit the large number of different viewer profiles that must be addressed.

The invention of independent claim 39 provides a truly revolutionary concept that would allow such familiar television broadcasters as ABC, NBC, CBS, etc., to prestore advertisement copy in people's homes based on users' profile information and substitute those commercials for commercials that they broadcast live over the air through the normal signal spectrum bandwidths allocated to the various ones of the public television broadcasting systems.

Although not specified in claim 39, the instant specification makes it clear that the advertising copy that is prestored in people's homes can be transmitted either via telephone or low bandwidth channels, such as AM and FM radio channels, via the Internet or other relatively slow broadcasting systems.

Regardless, claim 39 is clearly directed to an invention which is nowhere disclosed or even intimated or remotely suggested in any of the prior art of record. The remaining claims which are dependent on claim 39 impose further limitations thereon and are even further distanced from the prior art. As such, it is believed that all of the claims in the application are clearly patentable.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 30, 2004

Max Moskowitz

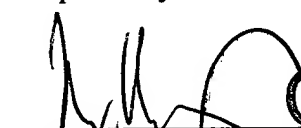
Name of applicant, assignee or
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Signature

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Date of Signature

Respectfully submitted,



MAX MOSKOWITZ

Registration No.: 30,576

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